

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 15, 2004. Applicants have amended Claim 9, 22, and 35. Applicants respectfully request reconsideration and favorable action in this case.

Examiner Interview and Finality of Next Office Action

The Attorney for Applicants, Chad C. Walters (Reg. No. 48,022), thanks the Examiner for the Examiner Interview conducted on Thursday, February 2, 2005. During the interview, the Examiner and the Attorney for Applicants discussed the motivation to combine the references used to reject the claims of the Application. Attorney for Applicants pointed out that the Examiner had not provided any motivation to combine the *Weisser* and *Malik* references in the Office Action of November 15, 2004 and inquired as to the motivation for combining such references. The Examiner instructed Applicants to address this issue in their next response. The Examiner also stated his understanding that a final rejection following this Office Action Response would be improper in light of his failure to provide a motivation to combine the *Weisser* and *Malik* references.

Allowable Subject Matter

Applicants note with appreciation the indication by the Examiner that Claims 7, 8, 20, 21, 33 and 34 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons discussed below, Applicant respectfully contends that each of Claims 7, 8, 20, 21, 33 and 34 are currently in condition for allowance.

Section 112 Rejections

The Office Action rejects Claims 9, 22, 23 and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that the phrase "the type of the request" is not clearly defined, has insufficient antecedent basis, and is confusing. *See* Office Action, page 2. Applicants respectfully traverse this rejection for the reasons stated below.

Applicants have amended the phrase “the type of request” to “a type of request” to resolve any antecedent basis issues.

35 U.S.C. § 112 requires that “the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” Applicants submit that the term “type of request for connection” particularly points out and distinctly claims the subject matter which Applicants regard as the invention. For example, the specification states that “[i]nformation collected by system 56 may include the users telephone number (caller ID), the called party’s telephone number, the user’s identification number, the user’s password, and/or the type of connection requested (i.e., leave a message(s), retrieve a message(s), etc...), as described above.” Application, page 19, lines 23-29. Thus, Applicants submit that the term “type of request for connection” is clearly defined and not confusing and request that the rejections of Claims 9, 22, 23, and 35 be withdrawn.

Section 103 Rejections

The Office Action rejects Claims 1, 2, 6, 11-15, 19, 24-28, 32 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,600,710 issued to Weisser et al., (“*Weisser*”) and in view of U.S. Patent No. 6,301,349 issued to Malik (“*Malik*”). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 1, 14, and 27 are directed to systems or methods including determining whether a messaging system is available and, if the messaging system is not available, queuing a request and maintaining a telecommunications connection between an access controller and a user while the request is queued. Applicants respectfully submit that neither *Weisser* nor *Malik*, either alone or in combination, disclose, teach, or suggest these elements. The Office Action admits that *Weisser* does not disclose a messaging system. See Office Action, page 3, item 3, line 8. Instead, *Weisser* discloses receiving a request to be connected with a called party. *Weisser* does not contemplate that the called party can be a messaging system. *Id.* The Office Action attempts to combine the voicemail service (“VMS”) of *Malik* with the teachings of *Weisser*. See Office Action, page 3, item 3, lines 8-9. However, the VMS of *Malik* is used to connect with unanswered calls that are directed to the called party, if the called party is unavailable. There is no disclosure, either in *Weisser* or *Malik*, for even

the possibility that a messaging system may be unavailable. For at least these reasons, Applicants respectfully submit that Claims 1, 14, and 27 are patentably distinguishable from the *Weisser* and *Malik* references and request that the rejections of Claims 1, 14, and 27 be withdrawn.

In addition, Applicants respectfully submit that the Examiner's proposed combination of *Weisser* and *Malik* is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law. In particular, Applicants respectfully submit that the Examiner's attempt to combine *Weisser* and *Malik* amounts to improper hindsight reconstruction of Applicants' invention, using Applicants' claims as a blueprint.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in one or more prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. As the M.P.E.P. states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art [at the time of the invention.]

M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. Moreover, "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432; *see also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "[t]he tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. As the Federal Circuit states:

A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'

In re Kotzab, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id*; *see also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With respect to the Examiner's proposed combination, the Examiner has not provided any motivation to combine the teachings of *Weisser* with *Malik*. First, the Examiner has not cited any portion of *Weisser* or *Malik* that would motive one skilled in the art to combine the references. Second, nothing in *Weisser*, *Malik*, or the knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed combination of *Weisser* and *Malik*. The Examiner's combination, in hindsight with the benefit of Applicants' claims as a roadmap, is insufficient under the M.P.E.P. and governing Federal Circuit case law.

The Examiner appears to have simply selected elements from the *Weisser* and *Malik* references to build the Applicants' invention. The Examiner did not point to any relevant portions of *Weisser* or *Malik* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to combine *Weisser* and *Malik*. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the teachings of *Weisser* a messaging system, as proposed by the Examiner, because *Weisser* and *Malik* teach different and mutually exclusive methods for handling calls when the called party is unavailable. *Weisser* teaches that calls are directed to a Service Node to play advertisements to the caller until the called party is available. *Malik*, on the other hand, teaches that calls are directed to a voicemail service when the called party is not available. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the teachings of *Weisser* a messaging system, as asserted by the Examiner. A purpose of the invention in *Weisser* is to maintain a connection with a calling party until a called party becomes available, while as discussed above, *Malik* directs calls to a voicemail service when a called party is unavailable. Thus, *Weisser* and *Malik* lack the required motivation to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Applicants respectfully note that "the factual inquiry whether to combine references must be thorough and searching." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001). Thus, the burden is on the Examiner to identify concrete evidence in the record to support his conclusion that it would have been obvious to modify the teachings of the cited reference to achieve the claimed

invention. *See, In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000). The Examiner's unsupported combination does not provide a thorough and searching factual inquiry and does not identify any concrete evidence in the record for modifying *Weisser*.

Moreover, the teachings of *Malik* explicitly teach away from a combination with *Weisser*. *Malik* explains that "the present invention minimizes the delay suffered by the caller during the process of connection." *Malik*, column 2, lines 43-45 (emphasis added). This is contradictory to the system of *Weisser* that "uses an AIN to allow a called party to place a call on hold while the called line is busy," and thereby introduce a delay for the calling party. *Weisser*, column 8, lines 54-56. This illustrates, once again, that the combination of *Weisser* and *Malik* is improper and cannot be used in an obviousness rejection under 35 U.S.C. § 103.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Weisser* and *Malik* in the manner the Examiner proposes, because *Weisser* and *Malik* explicitly teach away from a combination, and because the proposed combination fails to disclose all the elements of the claims, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner's proposed combination of *Weisser* and *Malik* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims in a manner not supported by the teachings of either *Weisser* or *Malik*. For at least these additional reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1, 14, and 27.

Claims 2, 6, and 11-13 depend from independent Claim 1. Claims 15, 19, and 24-26 depend from independent Claim 14. Claims 28, 32, and 37-39 depend from independent Claim 27. Therefore, Applicants respectfully submit that claims 2, 6, 11-13, 15, 19, 24-26, 28, 32, and 37-39 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

The Office Action rejects Claims 3-5, 16-18 and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al* as applied to Claim 1 above, and in view of U.S. Patent No. 6,519,333 issued to Malik ("*Malik-333*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 3-5 depend from independent Claim 1. Claims 16-18 depend from independent Claim 14. Claims 29-31 depend from independent Claim 27. Therefore, Applicants respectfully submit that claims 3-5, 16-18, and 29-31 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

Moreover, Claim 3 includes limitations regarding determining a class of service for the connection, and queuing the request based on the class of service. The Office Action relies upon a combination of *Weisser* and *Malik-333* in the rejection of Claim 3. However, neither *Weisser* nor *Malik-333* disclose queuing a request based on the class of service. In response to the Applicants' previous argument that this element is not disclosed, the Office Action cites to column 6, lines 14-19 of *Malik-333* and states that: "during the avenue of access to MLGH1, MLGH2, MLGH3, the class A user must be queued before either connecting or receiving a busy signal." Office Action, page 8. However, the cited portion of *Malik-333* merely discloses subscribers trying the next multi-line hunt groups (MLHGs) if MHLGs previously tried are busy. There is no disclosure for actually queuing a request based on a determined class of service.

Furthermore, the Examiner has not cited a proper motivation to combine *Weisser* and *Malik-333*, and the combination of *Weisser* and *Malik-333* is improper. The Office Action states that "[i]t would have been obvious to one skilled at the time the invention was made to modify *Weisser et al* to have the 'determining a class of service. . . queuing. . . CoS' as taught by *Malik-333* such that the modified system of *Weisser et al* would be able to support the CoS for queuing to the system users." Thus, the Office Action essentially states that the motivation to modify *Weisser* is so that the modified system includes the missing claim element. This is an improper motivation for modifying a reference to support a rejection under 35 U.S.C. § 103.

The Office Action rejects Claims 9, 10, 22, 23, 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al* as applied to Claim 3 above, and in view of *Malik, Malik-333*, and U.S. Patent No. 6,412,048 issued to Chauvel et al. ("*Chauvel*"). Applicants respectfully traverse these rejections for the reasons stated below.

Claims 9 and 10 depend from independent Claim 1. Claims 22 and 23 depend from independent Claim 14. Claims 35 and 36 depend from independent Claim 27. Therefore, Applicants respectfully submit that claims 9, 10, 22, 23, 35, and 36 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claims 1, 14, and 27.

The Office Action rejects Claim 40 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser*, and in view of *Malik*, and U.S. Patent No. 6,529,500 issued to Pandharipande ("*Pandharipande*"). The Office Action rejects Claim 41 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al*, as stated in Claim 40 above, and in view of *Malik, Malik-333* and *Pandharipande*. The Office Action rejects Claim 42 under 35 U.S.C. § 103(a) as being unpatentable over *Weisser et al*, as stated in Claim 40 above, and in view of *Malik, Pandharipande*, and in view of U.S. Patent No. 6,324,271 issued to Sawyer et al. ("*Sawyer*"). Applicants respectfully traverse these rejections for the reasons stated below.

Regarding Claim 40, the Office Action relies on *Weisser* in view of *Malik* as applied to Claim 1. As discussed above regarding Claim 1, the Office Action has stated no motivation to combine the VMS of *Malik* with the teachings of *Weisser*, the proposed combination is improper, and the proposed combination fails to disclose, teach, or suggest a messaging system being unavailable. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 40.

Claims 41 and 42 depend from independent Claim 40. Therefore, Applicants respectfully submit that claims 41 and 42 are patentably distinct from the cited references, for example, for at least the reasons discussed above regarding Claim 40.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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